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EXAMINER

MENBERU, BENIYAM

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/003,411	Applicant(s) GUPTON ET AL.	
	Examiner Beniyam Menberu	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 14, 21, 22, 27, 32, 33 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 14, 21, 22, 27, 32, 33 and 38-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Examiner's Amendment</u> |

Response to Arguments

1. Applicant's arguments, see Remark, filed January 5, 2007, with respect to claims 8, 9, 14, 21, 22, 27, 32, 33 and 38 have been fully considered and are persuasive. The objection of claims 8, 9, 14, 21, 22, 27, 32, 33 and 38 has been withdrawn.

Claim Objections

2. Claims 8, 9, 14 are objected to because of the following informalities:
- Claim 8, 12th line, "whether to process a document for electronic on non-electronic delivery based upon a document" should read "whether to process a document for electronic or non-electronic delivery based upon a document".
 - Claim 8, 13th line, "delivery designation stored in said consent database;" should read "delivery designation stored in a consent database;"
 - Claim 8, 23rd line, "a consent database, said consent database storing each potential document recipient's" should read "said consent database storing each potential document recipient's".
 - Claim 9, 12th line, "whether to process a document for electronic on non-electronic delivery based upon a document" should read "whether to

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process a document for electronic or non-electronic delivery based upon a document”.

- Claim 9, 13th line, “delivery designation stored in said consent database;” should read “delivery designation stored in a consent database;”.
- Claim 9, 23rd line, “a consent database, said consent database storing each potential document recipient's” should read “said consent database storing each potential document recipient's”.

- Replace Claim 14, lines 20–25 with the following:

“database based on the extracted identifying email data fields, (2) said failed email management system further comprises an Internet server, wherein said Internet server provides access for the intended recipient to correct said failed email addresses, and (3) said”

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 14, 22, 27, 33, and 38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20, 21, 26, and 28-30 of copending Application No. 10/813234. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

- Regarding claim 14,
- a document system, said document system producing document information for printing documents reads on "producing document data for printing documents" of claim 20 of copending application.
- a print management system, wherein said print management system accepts document data and document print requests from said document system, and further wherein said print management system determines whether a requested document is designated for electronic delivery or non-electronic delivery reads on "accepting requests to print selected documents; determining whether a

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selected document is accepted for electronic delivery or for non-electronic delivery” of claim 20 of copending application.

- a recipient database, wherein said recipient database stores recipient information reads on “the step of storing one or more preferred document delivery options for each potential document recipient” of claim 21 of copending application.
- a print system, wherein said print system is configured to receive and print documents designated for non-electronic delivery reads on “printing documents accepted for non-electronic delivery” of claim 20 of copending application.
- an email system, said email system configured to accept and process document data for creating and delivering documents electronically which reads on “the step of changing the preferred delivery option for the intended recipient of a failed email so that the intended recipient will no longer receive electronic documents” of claim 26 of copending application (since this claim 26 mentions email the document must be delivered electronically through email).
- a failed email management system, wherein said failed email management system is configured and arranged to receive a notice of a failed email delivery including a failed email address, and to change a document delivery designation for an intended recipient of a failed email so that the intended recipient will no longer receive electronic documents reads on “the step of changing the preferred delivery option for the intended recipient of a failed email so that the intended recipient will no longer receive electronic documents” of claim 26 of copending application and “extracting one or more identifying email data fields

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from said non-electronic notice of a failed email delivery and retrieving a name data field and an address data field from the recipient database based on the extracted one or more identifying email data fields" of claim 28 of copending application.

- " (1) said failed email management system extracts identifying email data fields from said notice of a failed email delivery and retrieves a name data field and an address data field from the recipient database based on the extracted identifying email data fields, (2) said failed email management system further comprises an Internet server, wherein said Internet server provides access for the intended recipient to correct said failed email addresses, and (3) The system of claim 13, wherein said failed email management system further comprises a postcard form template accessible via the Internet, wherein the intended recipient may print the postcard form template, provide information requested on the postcard form template and mail the postcard form template back for processing" which reads on claims 28-30 of copending application.

- Regarding claim 22,

"producing document data for printing documents; accepting requests to print selected documents;

determining whether a selected document is accepted for electronic delivery or for non-electronic delivery;

printing documents accepted for non-electronic delivery; electronically delivering

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documents accepted for electronic delivery" are evident in claim 20 of copending application.

"changing a corresponding document delivery designation if a failed email notification is received so that an intended recipient will no longer receive electronic documents" which reads on claim 26 of copending application.

"wherein the document delivery designations for multiple recipients are changed together based upon common identifying criteria" which reads on claim 25 of copending application.

"storing one or more preferred document delivery options for each potential document recipient, wherein said preferred document delivery options include an option to receive documents electronically and an option to receive documents non-electronically; determining whether to process a document for electronic delivery or for non-electronic delivery based upon the preferred document delivery option stored for each document recipient" reads on "determining whether a selected document is accepted for electronic delivery or for non-electronic delivery" of claim 20 of copending application and "the step of storing one or more preferred document delivery options for each potential document recipient" of claim 21 of copending application.

"and receiving document data for one or more documents selected for electronic delivery, and processing said document data for remote access and electronic document delivery" which reads on "storing documents and document data for documents accepted for electronic delivery; providing Internet access to the documents

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and document data accepted for electronic delivery” of claim 20 of copending application.

- Regarding claim 27, it contains similar limitations to claim 14 and in addition the limitation reads on “providing a non-electronic notice of a failed email delivery to the intended recipient of the failed email” of claim 27 of copending application.

Regarding claim 33,

- “producing document data for printing documents; accepting requests to print selected documents; determining whether a selected document is accepted for electronic delivery or for non-electronic delivery
printing documents accepted for non-electronic delivery; storing documents and document data for documents accepted for electronic delivery;
providing Internet access to the documents and document data accepted for electronic delivery;
providing notice regarding the status and availability of said stored documents and document data to intended document recipients” are evident in claim 20 of copending application.
- changing a preferred delivery option for the intended recipient of a failed email so that the intended recipient will no longer receive electronic documents which reads on claim 26 of copending application.

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- wherein the document delivery designations for multiple recipients are changed together based upon common identifying criteria which reads on claim 25 of copending application.
- storing one or more preferred document delivery options for each potential document recipient which reads on claim 21 of copending application.

Regarding claim 38,

- "producing document data for printing documents; accepting requests to print selected documents;
determining whether a selected document is accepted for electronic delivery or for non-electronic delivery;
printing documents accepted for non-electronic delivery; storing documents and document data for documents accepted for electronic delivery; providing Internet access to the documents and document data accepted for electronic delivery; providing notice regarding the status and availability of said stored documents and document data to intended document recipients " is evident in claim 20 of copending application.
- changing a preferred delivery option for the intended recipient of a failed email so that the intended recipient will no longer receive electronic documents reads on claim 26 of copending application.
- providing a non-electronic notice of a failed email delivery to the intended recipient of the failed email reads on claim 27 of copending application.

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- extracting one or more identifying email data fields from said non-electronic notice of a failed email delivery and retrieving a name data field and an address data field from the recipient database based on the extracted one or more identifying email data fields reads on claim 28 of copending application.
- providing Internet access for intended recipients to correct failed email addresses and to view document data reads on claim 29 of copending application.
- said method further the of providing a postcard form template accessible via the Internet, wherein the intended recipients may each print the postcard form template, provide information requested on the postcard form template and mail the postcard back to the appropriate department reads on claim 30 of copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 8 and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20 of copending Application No. 10/813234 in view of U.S. Patent No. 6088125 to Okada et al.

Regarding claim 32;

- producing document data for printing documents; accepting requests to print selected documents which reads on "producing document data for printing

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documents” and “accepting requests to print selected documents” of claim 20 of copending application.

- determining whether a selected document is accepted for electronic delivery or for non-electronic delivery which reads on “determining whether a selected document is accepted for electronic delivery or for non-electronic delivery” of claim 20 of copending application.
- printing documents accepted for non-electronic delivery; storing documents and document data for documents accepted for electronic delivery which reads on “printing documents accepted for non-electronic delivery; storing documents and document data for documents accepted for electronic delivery” of claim 20 of copending application.
- providing Internet access to the documents and document data accepted for electronic delivery which reads on “providing Internet access to the documents and document data accepted for electronic delivery” of claim 20 of copending application.
- providing notice regarding the status and availability of said stored documents and document data to intended document recipients which reads on “providing notice regarding the status and availability of said stored documents and document data to intended document recipients” of claim 20 of copending application.
- changing a preferred delivery option for the intended recipient of a failed email so that the intended recipient will no longer receive electronic documents which

reads on "the step of changing the preferred delivery option for the intended recipient of a failed email so that the intended recipient will no longer receive electronic documents" of claim 26 of copending application.

- wherein said preferred document delivery options include an option to receive documents electronically and an option to receive documents non-electronically which reads on "determining whether a selected document is accepted for electronic delivery or for non-electronic delivery" of claim 20 of copending application.

However copending Application No. 10/813234 does not disclose the combining of multiple electronic notices for delivery to a single recipient at one time.

Okada et al discloses the combining of multiple electronic notices for delivery to a single recipient at one time (column 13, lines 22-37; Figure 19).

Copending Application No. 10/813234 and Okada et al are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the multiple notice communication of Okada et al with the system of Copending Application No. 10/813234 to implement multiple notice transmission.

The motivation to combine the reference is clear because it would be convenient to receive all possible failures notices as shown in Okada et al in Figure 19.

Regarding claim 8, it contains similar limitations as in claim 32 above. In addition the limitations:

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- the recipient and consent database read on claim 21 of copending application.
- "a print system, wherein said print system is configured to receive and print documents designated for non-electronic delivery, wherein said print management system determines whether to process a document for electronic on non-electronic delivery based upon a document delivery designation stored in said consent database" read on "determining whether a selected document is accepted for electronic delivery or for non-electronic delivery; printing documents accepted for non-electronic delivery" of claim 20 of copending application and "the step of storing one or more preferred document delivery options for each potential document recipient" of claim 21 of copending application.
- "a parsing engine, wherein said parsing engine receives document data from said print management system for documents selected for electronic delivery, and further wherein said parsing engine processes said document data for storage; and
a server, wherein said server provides on-line access to the document data and electronic documents stored by said parsing engine" reads on "storing documents and document data for documents accepted for electronic delivery; providing Internet access to the documents and document data accepted for electronic delivery" of claim 20 of copending application.

- “a failed email management system, wherein said failed email management system is configured and arranged to receive a notice of a failed email delivery including a failed email address, and to change a document delivery designation for an intended recipient of a failed email so that the intended recipient will no longer receive electronic documents” which reads on claim 26 of copending application.
- “an email system, said email system configured to accept and process document data for creating and delivering documents electronically, wherein said email system composes and transmits electronic notices regarding the status and availability of stored documents and document data,” reads on providing notice regarding the status and availability of said stored documents and document data” of claim 20 and 26(mentions an email which reads on email system) of copending application.

However copending Application No. 10/813234 does not disclose the combining of multiple electronic notices for delivery to a single recipient at one time.

Okada et al discloses the combining of multiple electronic notices for delivery to a single recipient at one time (column 13, lines 22-37; Figure 19).

Copending Application No. 10/813234 and Okada et al are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the multiple notice communication of Okada et al with the

system of Copending Application No. 10/813234 to implement multiple notice transmission.

The motivation to combine the reference is clear because it would be convenient to receive all possible failures notices as shown in Okada et al in Figure 19.

This is a provisional obviousness-type double patenting rejection.

6. Claims 9 and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20 of copending Application No. 10/813234 in view of U.S. Patent No. 6956663 to Iida.

Regarding claim 9, it contains similar limitations as claim 8. In addition: "creating and delivering documents electronically, wherein said email system composes electronic documents comprised of document data and transmits said electronic documents to electronic document recipients" which reads on "A method for electronically delivering documents" of claim 20 and claim 26 which discloses of "email" which reads on transmitting documents by email. However copending Application No. 10/813234 does not disclose wherein said email system combines multiple electronic documents for delivery to a single recipient at one time.

Iida discloses combining multiple electronic documents for delivery to a single recipient at one time (column 11, lines 20-42).

Copending Application No. 10/813234 and Iida are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the multiple document transmission of lida with the system of copending Application No. 10/813234 to implement multiple documents transmission to a user.

The motivation to combine the reference is clear because it provides recipients of option to receive plurality of documents as needed.

Regarding claim 21,

"producing document data for printing documents; accepting requests to print selected documents;

determining whether a selected document is accepted for electronic delivery or for non-electronic delivery;

printing documents accepted for non-electronic delivery; electronically delivering documents accepted for electronic delivery" are evident in claim 20 of copending application.

"changing a corresponding document delivery designation if a failed email notification is received so that an intended recipient will no longer receive electronic documents;" reads on claim 26 of copending application.

"storing one or more preferred document delivery options for each potential document recipient, wherein said preferred document delivery options include an option to receive documents electronically and an option to receive documents non-electronically; determining whether to process a document for electronic delivery or for

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non-electronic delivery based upon the preferred document delivery option stored for each document recipient;" read on "determining whether a selected document is accepted for electronic delivery or for non-electronic delivery" of claim 20 and claim 21 of copending application.

"receiving document data for one or more documents selected for electronic delivery, and processing said document data for remote access and electronic document delivery; composing electronic documents from said document data" reads on "storing documents and document data for documents accepted for electronic delivery; providing Internet access to the documents and document data accepted for electronic delivery" of claim 20 and since claim 26 discloses email it implies composing of electronic documents used in email. However copending Application No. 10/813234 does not disclose wherein said email system combines multiple electronic documents for delivery to a single recipient at one time.

lida discloses combining multiple electronic documents for delivery to a single recipient at one time (column 11, lines 20-42).

Copending Application No. 10/813234 and lida are combinable because they are in the similar problem area of data communication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the multiple document transmission of lida with the system of copending Application No. 10/813234 to implement multiple documents transmission to a user.

The motivation to combine the reference is clear because it provides recipients of option to receive plurality of documents as needed.

This is a provisional obviousness-type double patenting rejection.

7. Claims 10 and 39-42 are rejected for depending on rejected claims 8, 9, 14, 21, 22, 27, 32, 33, and 38.

Allowable Subject Matter

8. Claims 8-10, 14, 21, 22, 27, 32, 33, and 38-42 would be allowable if double patent rejection is overcome.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

03/19/2007

A handwritten signature in cursive script, appearing to read "KAWilliams", is written in black ink.

**KIMBERLY WILLIAMS
PRIMARY PATENT EXAMINER**